Mailed: July 16, 2002
Paper No. 17
PTH

UNITED STATES PATENT AND TRADEMARK OFFICE

_____

Trademark Trial and Appeal Board

_____

In re E & E Hosiery Inc.

Serial No. 75/787,260

_____

Ezra Sutton for applicant.

Gina M. Fink, Trademark Examining Attorney, Law Office 103 (Michael Hamilton, Managing Attorney).

_____

Before Hairston, Bucher and Drost, Administrative Trademark Judges.

Opinion by Hairston, Administrative Trademark Judge:

E & E Hosiery Inc. has filed an application to register PLANET SOX as a mark on the Principal Register for "hosiery and socks."[1] The Trademark Examining Attorney has refused registration pursuant to Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that the

[1] Serial No. 75/787,260, filed August 30, 1999, based on a bona fide intention to use the mark in commerce. The word "SOX" has been disclaimed apart from the mark as shown.

use of applicant's mark for the identified goods is likely to cause confusion with the mark reproduced below,

for "clothes, namely, socks, tee shirts, ties, [and] suspenders."[2]

The case has been fully briefed, but no oral hearing was requested.

Before turning to the issue of likelihood of confusion, we must discuss an evidentiary matter. With its response to the Examining Attorney's first Office action, applicant submitted a search report from a private company's database of registered marks, which include the word PLANET. The Examining Attorney did not object to this material in her second Office action, and in fact discussed the material on its merits. Thereafter, with its

[2] Registration No. 2,082,764 issued July 29, 1997. The words "COLLECTION" and "SOCKS" have been disclaimed apart from the mark as shown.

appeal brief, applicant submitted a second search report from a private company's data base of registered marks which include the word PLANET. The Examining Attorney, in her brief, at note 1, objects to this material, pointing out that a search report from a private company's data base is not the proper way to make third-party registrations of record and that Trademark Rule 2.142(d) requires that the record in an application be complete prior to appeal. A review of the material submitted with applicant's brief reveals that many of the registrations listed therein are the same as those submitted with applicant's response to the Examining Attorney's first Office action.

The Board generally will not consider copies of a search report or information taken from a private company's database as credible evidence of the existence of the registrations listed therein. In re Hub Distributing, Inc., 218 USPQ 284 (TTAB 1983). In order to make third-party registrations of record, copies of the actual registrations or the electronic equivalent thereof, i.e., printouts of the registrations which have been taken from the USPTO's own computerized database, must generally be submitted. In this case, however, the deficiency in making third-party registrations of record by means of a search report could have been remedied by applicant if the

Examining Attorney had advised applicant in the second Office action. Having failed to do so, we must deem the Examining Attorney's discussion of the third-party registrations in her second Office action to be a stipulation that the search report could be used as evidence of the listed registrations. Accordingly, the first search report submitted by applicant will be considered. However, the second search report, which was submitted with applicant's brief, will not be considered because as the Examining Attorney notes, it is untimely pursuant to Trademark Rule 2.142(b).

We turn then to the issue of likelihood of confusion. Our determination under Section 2(d) is based on analysis of all of the probative facts in evidence that are relevant to the factors bearing on the likelihood of confusion issue. In re E. I. du Pont de Nemours and Co., 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In any likelihood of confusion analysis, two key factors are the similarities between the marks and the similarities between the goods. Federated Foods, Inc. v. Fort Howard Paper Co., 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

Turning first to the goods, we note that they are identical in part (socks) and otherwise related items of clothing. In view of the identity/relatedness of these

goods, they must be deemed to be sold in the same channels of trade to the same classes of customers, which in this case would include retail outlets such as mass merchandisers and department stores where the purchasers would be the general public.

Applicant does not dispute this, but concentrates the arguments in its appeal brief on the asserted weakness of registrant's mark and the asserted differences in the marks. In particular, applicant maintains that marks that include the word PLANET for clothing are weak marks and therefore not entitled to a broad scope of protection. In addition, applicant argues that the earth design in the registered mark serves to distinguish the registered mark from applicant's mark.

While we have carefully considered applicant's argument, we nonetheless find that as applied to the involved goods, applicant's mark PLANET SOX and the registered mark COLLECTION … PLANET SOCKS and design, are substantially similar in overall commercial impression.

In considering the marks, we recognize that the earth design in the registered mark cannot be ignored. However, although we have resolved likelihood of confusion by a consideration of the marks in their entireties, there is nothing improper in giving more weight, for rational

reasons, to a particular feature of a mark. See In re National Data Corp., 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985). In the present case, we believe it appropriate to give greater weight to the PLANET SOCKS portion of the registered mark because of the descriptive nature of the disclaimed word COLLECTION. Also, PLANET SOCKS is the portion of the registered mark most likely to be remembered and used by customers in calling for registrant's goods.

There is no question that the earth design in the registered mark is noticeable, and if we were making a side-by-side comparison of the mark, the differences in the marks would be obvious. This, however, is not the proper test. Rather, it is the overall commercial impression of the marks, which will be recalled by the average consumer that must be taken into account in determining likelihood of confusion. This is particularly true in this case because the goods can be relatively inexpensive and bought off the shelf in mass merchandisers and department stores, under conditions in which consumers will not take great care in making their purchases. In addition, the earth design in the registered mark does little to distinguish the registered mark from applicant's mark in overall commercial impression because the design simply reinforces the word PLANET.

In view thereof, and while differences admittedly exist between the respective marks, when considered in their entireties, and according appropriate weight to the dominant portions thereof, applicant's mark PLANET SOX is substantially similar in commercial impression to the registered mark COLLECTION … PLANET SOCKS and design.

As to applicant's argument that the registered mark is weak and therefore entitled to a limited scope of protection, the third-party registrations do not show that the public is familiar with the marks shown in the registrations, nor can they justify the registration of what could be another confusingly similar mark. While such registrations are probative of the fact the word PLANET has appealed to others in the clothing field and that the word is not particularly distinctive in the field, this fact does not help to distinguish applicant's mark PLANET SOX and the registered mark COLLECTION … PLANET SOCKS and design in terms of overall commercial impression. The word PLANET, as used in both marks, conveys the same meaning when combined with SOX and SOCKS, respectively. In short, PLANET SOX and PLANET SOCKS are synonymous terms. Further, we should also point out that none of the marks in the third-party registrations is as similar to the registered mark as is applicant's mark.

In sum, we find that in view of the substantial similarity in the overall commercial impression of applicant’s mark and the registered mark, their contemporaneous use on the identical and related goods involved in this case is likely to cause confusion as to the source or sponsorship of the goods.

Decision: The refusal to register under Section 2(d) of the Trademark Act is affirmed.